

Patent

Docket No. 4216-4000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue of

**Letters Patent 5,568,207**

Richard **CHAO**

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES

Examiner: H. Mai

Group Art Unit: 2873

**OFFER TO SURRENDER PATENT**

Commissioner for Patents  
Washington, D.C. 20231

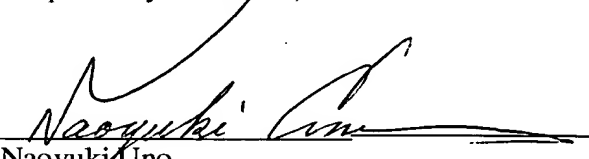
**SIR:**

I am empowered to sign this OFFER TO SURRENDER PATENT pursuant to 37 C.F.R. § 1.178 on behalf of the undersigned assignee, Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), who is the assignee of the entire right, title, and interest of a one-half part of United States Patent No. 5,568,207 recorded on **May 24, 2000, Reel 010848, Frame 0278**.

The undersigned assignee offers to surrender United States Patent No. 5,568,207 for its reissue.

Respectfully submitted,

Date: March 27, 2001

  
Naoyuki Uno  
Senior Managing Director  
Asahi Kogaka Kogyo Kabushiki Kaisha  
(A.K.A. Asahi Optical Co., Ltd.)

RECEIVED  
MAR 29 2001  
TECHNOLOGY CENTER 2800

Patent

Docket No. 4216-4000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue of

**Letters Patent 5,568,207**

Richard **CHAO**

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES :

Examiner: H. Mai

Group Art Unit: 2873

**SUBMISSION OF SUPPLEMENTAL REISSUE  
DECLARATION BY INVENTOR**

Commissioner of Patents  
Washington, D.C. 20231

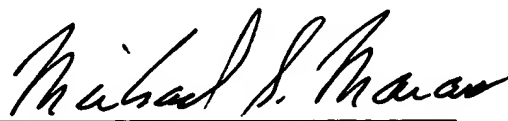
Sir:

Attached herewith is an executed Supplemental Reissue Declaration by Inventor, Richard Chao, for the above-identified reissue of U.S. Patent No. 5,568,207.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: March 29, 2001

By:



Michael S. Marcus

Registration No. 31,727  
(202) 857-7887 Telephone  
(202) 857-7929 Facsimile

CORRESPONDENCE ADDRESS:  
MORGAN & FINNEGAN, L.L.P.  
345 Park Avenue  
New York, NY 10154

RECEIVED  
MAR 29 2001  
TECHNOLOGY CENTER 2800

09/182,862-070401

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue of

**Letters Patent 5,568,207**

Richard CHAO

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES

Examiner: H. Mai

Group Art Unit: 2873

**SUBMISSION OF CONSENT OF ASSIGNEE**

Commissioner of Patents  
Washington, D.C. 20231

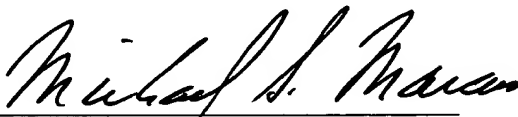
Sir:

Attached herewith is an executed Consent of Assignee by Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), for the above-identified reissue of U.S. Patent No. 5,568,207.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: March 29, 2001

By:

  
Michael S. Marcus  
Registration No. 31,727  
(202) 857-7887 Telephone  
(202) 857-7929 Facsimile

CORRESPONDENCE ADDRESS:  
MORGAN & FINNEGAN, L.L.P.  
345 Park Avenue  
New York, NY 10154

RECEIVED  
MAR 29 2001  
TECHNOLOGY CENTER 2800

Patent

Docket No. 4216-4000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue of

**Letters Patent 5,568,207**

Richard **CHAO**

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES

Commissioner of Patents  
Washington, D.C. 20231

:  
:  
:  
:  
:  
:  
:  
:  
:  
:  
:

Examiner: H. Mai

Group Art Unit: 2873

TECHNOLOGY CENTER 2800

MAR 29 2001

RECEIVED

**CONSENT OF ASSIGNEE**

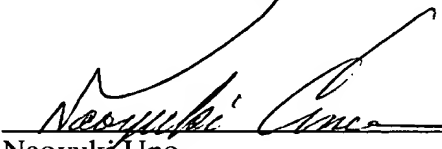
Sir:

I am empowered to sign this consent on behalf of the undersigned assignee, Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), who is the assignee of the entire right, title and interest of an undivided one half part of United States Patent No. 5,568,207 recorded on **May 24, 2000, Reel 010848, Frame 0278**.

The undersigned assignee **CONSENTS TO** the reissue of United States Patent No. 5,568,207, which reissue was filed on October 21, 1998.

Respectfully submitted,

Date: March 27, 2001

  
\_\_\_\_\_  
Naoyuki Uno  
Senior Managing Director  
Asahi Kogaka Kogyo Kabushiki Kaisha  
(A.K.A. Asahi Optical Co., Ltd.)

#25

Patent

Docket No. 4216-4000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue of

**Letters Patent 5,568,207**

Richard CHAO

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES

Examiner: H. Mai

Group Art Unit: 2873

TECHNOLOGY CENTER 2800

MAR 29 2001

RECEIVED

**SUBMISSION OF OFFER TO SURRENDER PATENT**

Commissioner of Patents  
Washington, D.C. 20231

Sir:

Attached herewith is an executed Offer to Surrender Patent by Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), assignee in the above-identified U.S. Patent No. 5,568,207.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: March 29, 2001

By: Michael S. Marcus  
Michael S. Marcus  
Registration No. 31,727  
(202) 857-7887 Telephone  
(202) 857-7929 Facsimile

CORRESPONDENCE ADDRESS:  
MORGAN & FINNEGAN, L.L.P.  
345 Park Avenue  
New York, NY 10154

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

The reissue oath/declaration is an essential part of a reissue application and must be filed with the application, or within the time period set under 37 CFR 1.53(f) along with the required surcharge as set forth in 37 CFR 1.16(e) in order to avoid abandonment.

The question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each case be reviewed and decided personally by the primary examiner.

Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

These elements will now be discussed:

# **I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT.**

In order to satisfy this requirement, a declaration can state:

"Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing."

Alternatively, a declaration can state:

"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent."

Where the specification or drawing is defective and patentee claimed more or less than patentee had the right to claim in the patent, then *both* statements should be included in the reissue oath/declaration. See MPEP § 1412.04 for an exemplary declaration statement when the error being corrected is an error in inventorship.

The above examples will be sufficient to satisfy this requirement without any further statement.

Form paragraph 14.01 may be used where the reissue oath/declaration does not provide the required statement as to applicant's belief that the original patent is wholly or partly inoperative or invalid.

## **¶ 14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of Defect in the Patent**

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. [1]

### **Examiner Note:**

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.

2. Form paragraph 14.14 must follow this form paragraph.

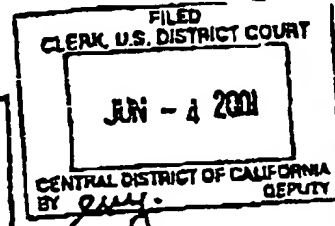
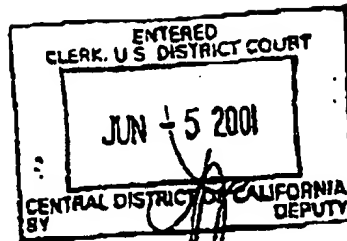
## **II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).**

A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an "error" in the original patent under 35 U.S.C. 251. See MPEP § 1402 for a discussion of grounds for filing a reissue that may constitute the "error" required by 35 U.S.C. 251. Not all changes with respect to the patent constitute the "error" required by 35 U.S.C. 251.

Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error.

Where more than one error is specified in the oath/declaration and some of the designated "errors" are found to not be "errors" under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.

The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the



☒ Priority  
☒ Send  
☐ Cisd  
☒ Enter  
☐ JS-5/JS-8  
☐ JS-2/JS-3

THIS CONSTITUTES NOTICE OF ENTRY  
AS REQUIRED BY FRCP, RULE 77(d).

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

ASPEX EYEWEAR, INC.

Plaintiff,

v.

REVOLUTION EYEWEAR, INC.

Defendant.

CV 99-1623 LGB (BQRx)

ORDER GRANTING PLAINTIFF'S  
MOTION FOR PARTIAL SUMMARY  
JUDGMENT ON DEFENDANT'S  
COUNTERCLAIM AND  
AFFIRMATIVE DEFENSE OF  
PATENT INVALIDITY

I. INTRODUCTION

This action arises out of Plaintiff Aspex Eyewear, Inc.'s allegation that Defendant Revolution Eyewear, Inc. is infringing upon its patent for magnetic eyewear. By the instant motion, Plaintiff seeks partial summary judgment on Defendant Revolution Eyewear Inc.'s counter-claim and affirmative defense of patent invalidity.

// ☒ Docketed  
// ☒ Copies / NTC Sent  
// ☒ JS - 5 / JS - 6  
// ☐ JS - 2 / JS - 3  
// ☐ CLSD

JUN 05 2001

183

1 II. FACTUAL BACKGROUND

2 Plaintiff purportedly has rights in U.S. Patent No. 5,568,207  
3 (the "'207 Patent") for a particular type of magnetic "clip-on"  
4 eyeglasses. See Def.'s Ex. 7 ('207 Patent). The patent was issued on  
5 October 22, 1996, and identifies the inventor of the device disclosed  
6 therein as a person by the name of Richard Chao ("Chao"). See id. at  
7 1.

8 A. DESCRIPTION OF THE PATENTED DEVICE

9 The '207 Patent relates to an eyeglass device comprising a  
10 primary spectacle frame for supporting primary lenses therein, and an  
11 auxiliary frame (colloquially known as the "clip-on" frame) for  
12 supporting auxiliary lenses. ('207 Patent, Abstract). The '207 Patent  
13 specifies an arrangement whereby the auxiliary frame is engaged to the  
14 primary spectacle frame using "magnetic members." See id. The two  
15 magnetic members of the primary frame are secured within "projections"  
16 that are in turn secured to the "rear and side portions" of the  
17 primary spectacle frame. ('207 Patent, col. 1, lns. 50-52 & Fig. 3).  
18 The two magnetic members of the auxiliary frame are secured to the  
19 "arms," which are in turn secured to the two "side portions" of the  
20 auxiliary frame. (Id. at col. 1, lns. 54-55 & Fig. 4). The arms of the  
21 auxiliary frame extend over, and engage with, the upper portion of the  
22 primary spectacle frame, such that the magnetic members of the two  
23 frames engage with each other. (Id. at lns. 55-58 & Fig. 5). The  
24 arrangement prevents the auxiliary frame from moving downward relative  
25 to the primary spectacle frame, thereby enabling the auxiliary frame  
26 to be stably supported. (Id. at col. 1, ln.62 - col.2, ln. 2).  
27  
28



1 B. DEFENDANT'S INVALIDITY COUNTERCLAIM

2 On February 17, 1999, Plaintiff filed suit against Defendant, on  
3 the grounds that its magnetic eyewear infringed upon the '207 Patent.  
4 See Pl.'s Compl. On March 11, 1999, Defendant filed a counterclaim,  
5 seeking a declaration that the '207 Patent is invalid, and an  
6 affirmative defense of invalidity. See Def.'s Counterclaim & Answer.

7 Defendant bases its invalidity claim on the contention that an  
8 inventor by the name of Julie Madison ("Madison") is the first true  
9 inventor of the device claimed in the '207 Patent. Madison is the  
10 holder of U.S. Patent No. 6,149,269 (the "'269 Patent") for  
11 "Eyeglasses Having Magnetically Held Auxiliary Lenses." See Def.'s Ex.  
12 1 ('269 Patent). Madison applied for the patent on April 18, 1997, and  
13 the '269 Patent was issued on November 21, 2000. See id. The '269  
14 Patent describes itself as an improvement over prior art because of  
15 its "uniblock" design:

16 Eyeglasses and clip-ons are improved by providing  
17 housings for magnets for securing the clip-ons in a  
18 uniblock also incorporating one or more of the  
19 following: parts of closing block, an end piece, and  
20 part of a hinge. The structure is more compact, neater  
21 in appearance, and of improved quality as compared to  
22 eyeglasses incorporating conventional structures . . .

23 See '269 Patent, Abstract. See also id. at col. 1, lns. 38-42  
24 ("In eyeglasses constructed in accordance with the prior art, the  
25 piecemeal assembly of closing block, end piece, magnet housing  
26 and temple-piece hinge produces a structure that is unduly strung  
27 out or elongate, and the housing for the magnet is bulky and  
28 unsightly.") Significantly, the '269 Patent identifies the device  
disclosed in the '207 Patent as a prior art reference. See id. at  
1 (References Cited); id. at col. 1, lns. 13-25 ("Eyaglasses

1 equipped with one or more magnets adapted to secure an auxiliary  
2 lens in superimposed relation to a primary lens are known and  
3 disclosed for example in Chao U.S. Pat. No. 5,586,207.<sup>1</sup>)

4 Madison purportedly began designing eyewear in or around  
5 1978. See Madison Depo., Vol. 1 at 6. Madison asserts that, in  
6 the summer of 1994, she conceived of a variety of embodiments for  
7 eyeglasses that utilize a magnet to attach an auxiliary frame to  
8 a primary frame, in a uniblock (also known as a "monoblock")  
9 configuration.<sup>2</sup> See id. at 16:5-19:7; Madison Depo., Vol. 2 at  
10 189-190. Madison claims that she conceived of a number of  
11 orientations for the magnets during the summer of 1994, including  
12 "magnets mounted on the front, magnets mounted on the top, and  
13 . . . magnets mounted . . . vertically and horizontally." Id. at  
14 24:16-23. Madison also purportedly conceived of a design whereby  
15 the arms of the auxiliary frame would "go directly over" the  
16 front portion of the primary frame. See id. at 25-27. Madison  
17 apparently committed her ideas and designs to paper during 1994.  
18 See id. at 27-28.<sup>3</sup>

19  
20  
21 <sup>1</sup> As described by Madison, a monoblock configuration is one where  
22 "all the parts, the rimlock, the hinge, and in this case the magnet, the  
23 end piece, are constructed from a single piece of metal." Madison Depo.,  
24 Vol. 1 at 45.

25 <sup>2</sup> "Q: Now, did you prepare any notes or writing that related to  
26 this conception?

27 A: Yes.

28 Q: And in what format did you maintain those notes?

A: Some are in notebooks, some are on -- depends on where I was.  
Some were on box tops. Depending what I was doing at that  
time. Some were on random pieces of paper."

See Madison Depo., Vol. 1 at 27-28.

06/11/01 14:48

213 238 1300

BROBECK

0025

06/05/2001 17:41 FAX 415 442 1010

BROBECK SF

0007

1 Also in the summer of 1994, Madison allegedly met with a  
2 person by the name of Mr. Kimura, who worked for a company called  
3 Sunreeve. See id. at 30; Madison Depo., Vol. 2 at 177. At their  
4 meeting in Norwood, New Jersey, Kimura purportedly showed Madison  
5 a sample of magnetic eyewear wherein the magnets were placed in a  
6 front-mounted configuration. See Madison Depo., Vol. 1 at 32:21-  
7 33:24. As they discussed the sample, Madison asserts that she  
8 disclosed certain aspects of the invention she had conceived.  
9 See id. at 34. Specifically, Madison purportedly discussed her  
10 idea for magnetic eyewear with back-mounted magnets. See id.; see  
11 also id. at 47 (Madison's testimony that she disclosed "the  
12 substance of" her U.S. Patent application to Kimura). However,  
13 Madison did not disclose any of her previously-made notes and  
14 drawings to Kimura. See Madison Depo., Vol. 2 at 207-208.  
15 Instead, Madison and Kimura purportedly made drawings during the  
16 course of their meeting, incorporating Madison's uniblock design.  
17 See id. In addition, Madison asked Mr. Kimura and Sunreeve to  
18 create an eyeglass sample with top-mounted magnets and a  
19 monoblock configuration. See id. at 177, 190. While Madison did  
20 not enter into any formal confidentiality agreement with Kimura  
21 or Sunreeve (see Madison Depo., Vol. 1 at 44:12-45:2), Madison  
22 testified that she did expect Kimura to refrain from disclosing  
23 her ideas and drawings to other people within the industry.  
24 See Madison Depo., Vol. 2 at 210-211.'

25  
26 ' "Q: Would it be fair to say . . . that your discussions with Mr.  
27 Kimura that day in Anaheim when you went over these drawings were not  
28 meant to be disclosed to anyone else in the industry?

A: I had expected that he would go back to his office and discuss  
it with his technical people 'cause he's not a technical - although

1 At a subsequent meeting in Anaheim, California in October of  
2 1994, Kimura informed Madison that Sunreeve could not produce a  
3 sample of a top-mounted monoblock design, because of the  
4 technical difficulties it posed. See Madison Depo., Vol. 2 at  
5 177-178; 190-192; 205:9-18. Thereafter, in April 18, 1997,  
6 Madison applied for, and subsequently received, the '269 Patent.

7  
8 III. PROCEDURAL BACKGROUND

9 Plaintiff filed the instant patent infringement action  
10 against Defendant on February 17, 1999. Defendant filed an Answer  
11 on March 11, 1999. Defendant also filed two counterclaims. The  
12 first counterclaim seeks a declaration that its frames do not  
13 infringe the '207 Patent, and the second counterclaim seeks a  
14 declaration that the '207 Patent is invalid.

15 On June 2, 1999, Defendant filed a motion to stay this  
16 action pending the conclusion of an interference proceeding by  
17 the PTO to determine who, as between Richard Chao and inventor  
18 Toshikazu Iwamoto, was the first to invent the device claimed in  
19 the '207 Patent. On September 10, 1999, the Court ordered a stay  
20

21 he's very bright, he's not the technical guy.

22 Q: Now, you expected him to talk to people within Sunreeve?

23 A: Right.

24 Q: Right. But you didn't expect him to go to talk to other people  
25 within the industry?

26 A: Correct.

27 Q: Did you want him to keep the information a secret?

28 A: That would be yes."

See Madison Depo., Vol. 2 at 210-212.

1 of the action. On or about May 30, 2000, Richard Chao prevailed  
2 in the interference proceeding, and the Court thereafter vacated  
3 the stay on July 25, 2000.

4 On April 12, 2001, Plaintiff filed the instant motion for  
5 partial summary judgment on Defendant's invalidity counterclaim  
6 and affirmative defense. Defendant filed an opposition on April  
7 23, 2001, to which Plaintiff replied on April 30, 2001.\*

8  
9 IV. SUMMARY JUDGMENT STANDARD

10 Rule 56 of the Federal Rules of Civil Procedure provides  
11 that a court shall grant a motion for summary judgment if "the  
12 pleadings, depositions, answers to interrogatories, and  
13 admissions on file, together with the affidavits, if any, show  
14 that there is no genuine issue as to any material fact and that  
15 the moving party is entitled to judgment as a matter of law."  
16 Fed. R. Civ. P. 56(c). Material facts are those that may affect  
17 the outcome of the case. See Anderson v. Liberty Lobby, Inc.,  
18 477 U.S. 242, 248 (1986). A dispute as to a material fact is  
19 genuine if there is sufficient evidence for a reasonable jury to  
20 return a verdict for the nonmoving party. See id.

21 The party moving for summary judgment bears the initial  
22 burden of informing the district court of the basis of the  
23 summary judgment motion, and of demonstrating the absence of a

24  
25 \* In its motion, Plaintiff also represents that Defendant agreed to  
26 dismiss its fifth affirmative defense of statute of limitations, and its  
27 ninth affirmative defense of laches. See Totino Decl. ¶2 & Ex. A.  
28 Defendant's opposition does not indicate whether it agrees with this  
representation. As these affirmative defenses are not made a part of  
Plaintiff's motion for summary judgment, the Court will not dismiss such  
defenses in the absence of a stipulation between the parties.

06/11/01 14:47

213 239 1300

BROBECK

0208

06/05/2001 17:42 FAX 415 442 1010

BROBECK SF

010

1 genuine issue of material fact for trial. See Celotex Corp. v.  
2 Catrett, 477 U.S. 317, 323 (1986); Katz v. Children's Hosp. of  
3 Orange County, 28 F.3d 1520, 1534 (9th Cir. 1994). On an issue  
4 for which the nonmoving party has the burden of proof at trial,  
5 the moving party need only point out "that there is an absence of  
6 evidence to support the nonmoving party's case." Celotex, 477  
7 U.S. at 325. Once this initial burden is satisfied, the non-  
8 moving party is required to "go beyond the pleadings and by her  
9 own affidavits, or by the depositions, answers to  
10 interrogatories, and admissions on file, designate 'specific  
11 facts' showing that there is a genuine issue for trial." Celotex,  
12 477 U.S. at 324 (internal quotations omitted). See also Nilsson,  
13 Robbins, Dalgarn, Berliner, Carson & Wurst v. Louisiana Hydrolec,  
14 854 F.2d 1538, 1544 (9th Cir. 1988). Where the standard of proof  
15 at trial is preponderance of the evidence, the non-moving party's  
16 evidence must be such that a "fair-minded jury could return a  
17 verdict for the [non-moving party] on the evidence presented."  
18 Anderson, 477 U.S. at 252.

## 19 V. ANALYSIS

### 20 A. LEGAL STANDARD FOR PATENT INVALIDITY

21 Patents enjoy a statutory presumption of validity. See 35  
22 U.S.C. § 282 (1994). The party seeking to establish a patent's  
23 invalidity must do so by clear and convincing evidence. Id.; Eli  
24 Lilly & Co. v. Barr Laboratories, Inc., 222 F.3d 973, 980 (Fed.  
25 Cir. 2000). "If the evidence requires the fact finder to draw  
26 extensive inferences, the evidence does not satisfy the clear and  
27 convincing proof requirement." Hay & Forage Industries v. Now  
28

06/11/01 14:48

213 239 1300

BROBECK

0029

06/05/2001 17:43 FAX 415 442 1010

BROBECK SF

0011

1 Holland North America, Inc., 60 F.Supp.2d 1099, 1119 (D.Kan.  
2 1998).

3 "[A] moving party seeking to have a patent held not invalid  
4 at summary judgment must show that the nonmoving party, who bears  
5 the burden of proof at trial, failed to produce clear and  
6 convincing evidence on an essential element of a defense upon  
7 which a reasonable jury could invalidate the patent." *Id.*

8 A patent may be rendered invalid if it is anticipated by  
9 prior art. Invalidity based on anticipation is described in 35  
10 U.S.C. § 102(a):

11 A person shall be entitled to a patent unless -  
12 (a) the invention was known or used by others in this  
13 country, or patented or described in a printed  
14 publication in this or a foreign country, before  
15 invention thereof by the applicant for the patent.

16 See 35 U.S.C. §102(a). In essence, this statutory provision  
17 requires an invention to be "new" in order to be patentable.

18 See 1 Chisum, Chisum on Patents, §3.01 at 3-3 (2000).

19 Here, Defendant argues that the Madison drawings disclosed  
20 to Kimura constitute prior art that anticipates and invalidates  
21 the '207 Patent. To withstand Plaintiff's motion for summary  
22 judgment, Defendant must produce sufficient evidence to permit a  
23 reasonable finder of fact to find patent invalidity on this basis  
24 by clear and convincing evidence. See Anderson v. Liberty Lobby,  
25 Inc., 477 U.S. at 254.<sup>5</sup>

26 <sup>5</sup> As a preliminary matter, Plaintiff argues that Defendant is  
27 precluded from arguing anticipation because Madison's own patent refers  
28 to the Chao invention as a prior art reference. See '269 Patent at 1  
(References Cited); *id.* at col. 1, lns. 13-25. "A statement in a patent  
that something is in the prior art is binding on the applicant and  
patentee for determinations of anticipation and obviousness." Constant

08/11/01 14:48

213 238 1300

BROBECK

0030

06/05/2001 17:43 FAX 415 442 1010

BROBECK SF

0012

## 1 B. APPLICATION

2 "A patent is invalid for anticipation when the same device  
3 or method, having all of the elements and limitations contained  
4 in the claims, is described in a single prior art reference." ATD  
5 Corporation v. Lydall, Inc., 159 F.3d 534, 545 (Fed. Cir. 1998).

6 In order to invalidate a patent based on anticipation, the  
7 Court must undertake a three-step analysis. First, the Court must  
8 determine whether the purportedly anticipating invention is  
9 indeed a prior art reference. See Purdue Pharma L.P. v.

10 Boehringer Ingelheim, GMBH, 237 F.3d 1359, 1365 (Fed. Cir. 2001).

11 In other words, does the reference pre-date the invention of the  
12 patent-in-suit? Second, the Court must compare the claims of the  
13 patent-in-suit to the prior art, to determine whether the prior  
14 art reference discloses each and every limitation of the  
15 invention claimed in the patent-in-suit. See Heliflix Limited v.  
16 Blok-Lok Limited, 208 F.3d 1339, 1346 (Fed. Cir. 2000). See also  
17 Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367

18 (Fed. Cir. 1986) ("It is axiomatic that for prior art to  
19 anticipate under §102 it has to meet every element of the claimed  
20 invention . . ."). Third, the Court must determine whether the  
21 prior art reference was either "known or used by others in this

22 \_\_\_\_\_  
23 v. Advanced Micro Devices, Inc., 848 F.2d 1560, 1570 (Fed. Cir. 1988).  
24 Thus, Madison's description of the '207 Patent as a prior art reference  
25 constitutes an admission of this fact as to Madison. However, Plaintiff  
26 identifies no cases, and the Court has found none, indicating that the  
27 scope of the admission extends to third parties seeking to raise an  
28 invalidity defense. Thus, the Court is hesitant to rest upon this  
admission alone in assessing the viability of Defendant's counterclaim.  
Nevertheless, it is significant that Defendant places virtually  
exclusive reliance upon Madison's deposition testimony to prove a  
contention that Madison herself is barred from making.



08/11/01 14:48

213 239 1300

BROBECK

0031

06/05/2001 17:43 FAX 415 442 1010

BROBECK SF

0013

country", or "described in a printed publication in this or a foreign country." 35 U.S.C. §102(a). Anticipation is a question of fact that is subject to review under the clearly erroneous standard. See In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986).

1. WHETHER THE MADISON INVENTION IS A PRIOR ART REFERENCE

A reference constitutes prior art only if it predates the date of invention of the device claimed in the patent-in-suit. See 35 U.S.C. §102(a). The presumptive date of invention for any device is the date upon which a complete patent application is filed in the Patent and Trademark Office ("PTO"). See Cooper v. Goldfarb, 154 F.3d 1321, 1327 (Fed.Cir. 1998); Bates v. Coe, 98 U.S. 31, 34 (1878). A patentee may establish an earlier date of invention, however, by showing either (1) "an earlier reduction to practice," (Purdue, 237 F.3d at 1365); or (2) "an earlier conception followed by a diligent reduction to practice." Id. "Conception and reduction to practice are questions of law, based on subsidiary findings of fact." Id.

Here, the presumptive date of invention of Chao's eyeglass device is November 7, 1995 -- the date Chao filed his patent application with the PTO. See Pl.'s Ex. 7. The presumptive date of invention of Madison's eyeglass device is seventeen months later, on April 18, 1997 -- the date upon which Madison filed her patent application. See Pl.'s Ex. 1. Thus, in order for Defendant to establish that Madison's invention is a prior art reference, it must raise a genuine issue of material fact that Madison either reduced her invention to practice before November 7, 1995, or conceived of her invention and diligently worked to reduce it

08/11/01 14:49

213 239 1300

BROBECK

0032

08/05/2001 17:43 FAX 415 442 1010

BROBECK SF

0014

1 to practice before November 7, 1995.

2 (a) Actual Reduction to Practice

3 To prove actual reduction to practice, "an  
4 inventor must establish that he actually prepared the composition  
5 and knew it would work." Estee Lauder Inc. v. L'Oreal S.A., 129  
6 F.3d 588, 592 (Fed.Cir.1997); Markman v. Lehman, 987 F.Supp. 25,  
7 30 (1997) ("Proof of actual reduction to practice requires a  
8 showing that the apparatus actually existed and that it worked  
9 for its intended purpose.") "To establish an actual reduction to  
10 practice, an inventor must provide independent corroborating  
11 evidence in addition to his or her own statements and documents,  
12 such as testimony of a witness other than the inventor or  
13 evidence of surrounding facts and circumstances independent of  
14 information received from the inventor." Markman, 987 F.Supp. at  
15 30. "The purpose of this rule is to prevent fraud." Id.

16 Here, Defendant does not attempt to provide any evidence  
17 that Madison actually reduced her eyeglass device to practice.  
18 prior to the filing of the Chao patent application on November 7,  
19 1995. Indeed, the only evidence in the record is the  
20 uncorroborated testimony of Madison that the first specimen  
21 embodying her patented invention was produced in 1996. See  
22 Madison Depo., Vol. 2 at 228-229. Thus, Madison cannot establish  
23 priority on this basis.

24 (b) Conception and Diligent Reduction to  
25 Practice

26 Defendant seeks to establish priority on the  
27 alternative basis that Madison conceived of her invention, and  
28 diligently worked to reduce it practice, prior to November 7,

06/11/01 14:49

213 239 1300

BROBECK

0033

06/05/2001 17:44 FAX 415 442 1010

BROBECK SF

0015

1 1995. Conception "requires proof that the inventor formed in his  
2 mind 'a definite and permanent idea of the complete and operative  
3 invention, as it is hereafter to be applied in practice,' and  
4 that the idea be 'so clearly defined in the inventor's mind that  
5 only ordinary skill would be necessary to reduce the invention to  
6 practice, without extensive research or experimentation.'" Id.  
7 (quoting Burroughs Wellcome Co. v. Barr Labs. Inc., 40 F.3d  
8 1223, 1228 (Fed.Cir. 1994). Where a party seeks to show  
9 conception through oral testimony of an inventor, it must produce  
10 independent evidence corroborating that testimony. See Purdue,  
11 237 F.3d at 1365. Indeed, "[p]roof of an alleged inventor's  
12 conception and reduction to practice is a heavy one and requires  
13 full corroboration by other than the inventor's own self-serving  
14 testimony or records." Potter Instrument Co., Inc. v. Odeh  
15 Computer Systems, Inc., 370 F.Supp. 198, 206 (D.R.I. 1974)  
16 (quoting Eastman Kodak Co. v. E. I. DuPont de Nemours & Co., 298  
17 F.Supp. 718, 728 (E.D.Tenn. 1969)).

18 In order to show due diligence in the inventor's reduction  
19 to practice, "the patentee must account for the entire critical  
20 period between the date of conception and the date of reduction  
21 to practice by showing either activity aimed at reduction to  
22 practice or legally adequate excuses for inactivity." American  
23 Standard, Inc. v. Pfizer, Inc., 722 F.Supp. 86, 109 (D.Del. 1989)  
24 (citing 3 D. Chisum, Patents § 10.07 (1987)). "In addition, the  
25 law requires corroboration of diligence during the critical  
26  
27  
28

06/11/01 14:49

213 239 1300

BROBECK

0034

06/05/2001 17:44 FAX 415 442 1010

BROBECK SF

0016

1 period." American Standard, 722 F.Supp. at 109.<sup>6</sup>

2 Relying on Madison's deposition testimony, Defendant  
3 contends that Madison conceived of her magnetic eyewear in the  
4 summer of 1994. See Madison Depo., Vol. 1 at 16:5-19:7; Madison  
5 Depo., Vol. 2 at 185-190. The only purportedly corroborating  
6 evidence provided by Defendant are declarations of Kimura and  
7 Takahiro Nishioka (Deputy General Manager of Sunreeve) that were  
8 allegedly submitted to the PTO in the prosecution of Madison's  
9 patent. See Def.'s Opp'n. at 2; Def.'s Exs. 5 & 6. However,

10 Plaintiff properly objects to the admission of the declarations  
11 because they are improperly authenticated. "In order for a  
12 document to be considered by a court in ruling on a motion for  
13 summary judgment, the document must be authenticated by and  
14 attached to an affidavit that meets the requirements of  
15 Fed.R.Rule.P. 56(e). . . ." See Countryside Oil Co., Inc. v.  
16 Travelers Insurance Co., 928 F.Supp. 474, 482 (D.N.J. 1995).  
17 "Hence, before evidence may be admitted, a foundation must be  
18 laid 'by evidence sufficient to support a finding that the matter  
19 in question is what its proponent claims.'" Id. (quoting Fed. R.  
20 Evid. 901(a)).

21 Here, the supporting affidavit by defense counsel Crucillo  
22 does not state that the declarations are "true and correct"  
23 copies of what they purport to be. See Crucillo Decl. ¶¶ 6-7.  
24 Indeed, the file history for Madison's '269 Patent nowhere

25  
26  
27 "The "critical period" of diligence is "from the time just before  
28 the entry of a second inventor into the field until a reduction to  
practice." American Standard, 722 F.Supp. at 114, n.21; Driscoll v.  
Cebalo, 5 U.S.P.Q.2d 1477, 1481 n. 6 (P.T.O. 1982) (diligence is required  
only "from a time prior to the conception of another").

- 14 -

06/05/2001 TUE 16:19 [TX/RX NO 0006] 0015

06/05/2001 TUE 17:38 [TX/RX NO 0285] 0016

08/11/01 14:50

213 238 1300

BROBECK

0035

06/05/2001 17:44 FAX 415 442 1010

BROBECK SF

0017

1 includes the foregoing declarations, and Defendant provides no  
2 other evidence that the declarations were ever used in the patent  
3 prosecution. See Totino Decl., Ex. A. Thus, the Court sustains  
4 Plaintiff's objection to the admissibility of the declarations.

5 Even if the Court were to assume that conception occurred in  
6 the summer of 1994, the record is devoid of evidence concerning  
7 Plaintiff's diligent reduction to practice. Again, Defendant  
8 relies on Madison's own deposition testimony, which is  
9 insufficient as a matter of law because it is uncorroborated. See  
10 American Standard, 722 F.Supp. at 109 ("the law requires  
11 corroboration of diligence during the critical period.") Even if  
12 the inadmissible declarations of Kimura and Nishioka are  
13 considered, they are entirely silent as to Madison's attempts, if  
14 any, to reduce her invention to practice. In fact, Nishioka's  
15 declaration provides the opposite inference when it states: "I  
16 replied to Ms. Julie Madison through Mr. Kaoru Kimura that her  
17 ideas would not be realized if we used such new construction for  
18 magnetic eyewear." See Def.'s Ex. 5, Nishioka Decl. at ¶3.

19 Thus, Defendant's evidence falls far short of raising a  
20 genuine issue of material fact that Madison's ideas and drawings  
21 constitute a prior art reference, especially in light of the  
22 governing clear and convincing burden of proof. Conspicuously  
23 absent from the record are the drawings themselves, upon which  
24 the entirety of Defendant's counterclaim is premised. When  
25 stripped to its essence, the evidence is nothing more than  
26 testimony by the inventor herself, corroborated only by ambiguous  
27 and inadmissible declarations. For this reason alone, partial  
28 summary judgment in favor of Plaintiff is appropriate.

08/11/01 14:50

213 238 1300

BROBECK

0036

06/05/2001 17:45 FAX 415 442 1010

BROBECK SF

0018

2. WHETHER THE MADISON INVENTION WAS KNOWN OR  
USED BY OTHERS OR DESCRIBED IN A PRINTED  
PUBLICATION

Another crucial element of an anticipation defense is proving that the prior art reference was known or used by others, or described in a printed publication, prior to the invention of the device disclosed in the patent-in-suit. See 35 U.S.C. §102(a).

(1) Description in a Printed Publication

Anticipation by a prior publication occurs where the work adequately describes the invention in question and the work qualifies as a printed publication. See 1 Chisum, Chisum on Patents, §3.04 at 3-40. In order for a description to be "adequate", it must enable a person with ordinary skill in the art to not only comprehend the invention, but also to make it. See Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1550 (Fed.Cir. 1989) (a prior art reference "must provide a description sufficient to teach a person of ordinary skill in the art how to make and use the apparatus or process"); Seymour v. Osborn, 78 U.S. 516 (1870).

In order for the prior art reference to qualify as a "printed publication" under 35 U.S.C. §102(a), it must have been "sufficiently accessible to those skilled in the art." In re Cronyn, 890 F.2d 1158, 1160 (Fed.Cir. 1989). This is because "dissemination and public accessibility are the keys to a legal determination whether a prior art reference was 'published'." Id. See also Deep Welding, Inc. v. Sciaky Bros., Inc., 417 F.2d 1227, 1235 (7th Cir. 1969) (distribution of paper at various technological conferences sufficed to constitute publication);

- 16 -

08/05/2001 TUE 16:19 (TX/RX NO 8800) 0017

06/05/2001 TUE 17:38 (TX/RX NO 8285) 0018

Jun 11 01 05:50p

Thierry's Desk

(954)432-3840

p. 4

08/11/01 14:50

213 239 1300

BROBECK

0037

06/05/2001 17:45 FAX 415 442 1010

BROBECK SF

0019

1 compare Preemption Devices, Inc. v. Minnesota Mining & Mfg. Co.,  
2 732 F.2d 903 (Fed. Cir. 1984) ("the dissemination of six copies to  
3 an individual was not a 'publication' . . .").

4 Here, Defendant's evidence fails to raise a genuine issue of  
5 material fact that the Madison drawings qualify as a "printed  
6 publication". The evidence does not indicate that the Madison  
7 drawings, assuming that they exist, were made accessible to  
8 members of the public. Rather, Madison testified that she did not  
9 disclose any drawings in her notebook to Kimura, and that Kimura  
10 saw only those drawings that were created in the course of the  
11 parties' 1994 meeting in New Jersey. See See Madison Depo., Vol.  
12 2 at 207-208. Moreover, there is no evidence that persons other  
13 than Kimura ever saw Madison's drawings, including other  
14 employees of Sunxreeve. Finally, Madison testified that, while  
15 there was no confidentiality agreement with Kimura, she expected  
16 Kimura to refrain from disclosing her ideas and drawings to other  
17 persons in the optical industry. See Madison Depo., Vol. 1 at  
18 44:12-45:2; Madison Depo., Vol. 2 at 210-211.

19 Defendant's evidence also fails to raise a genuine issue of  
20 material fact that the Madison drawings were sufficiently  
21 detailed to enable a person with ordinary skill in the art to  
22 both comprehend the invention and to make it. Indeed, the only  
23 evidence submitted suggests that the Madison drawings disclosed  
24 to Kimura were not sufficient to enable him to create the sample  
25 requested by Madison. See Madison Depo., Vol. 2 at 190-192;  
26 209:9-18; 177-178.<sup>7</sup>

27  
28 "Q: And after you gave [Kimura] specifications [of the top-mounted  
monoblock design], he later came back to you and said that it could not

- 17 -

06/05/2001 TUE 18:19 [TX/RX NO 85061] 0018

06/05/2001 TUE 17:38 [TX/RX NO 82851] 0019

06/11/01 14:51

213 238 1300

BROBECK

0038

06/05/2001 17:45 FAX 415 442 1010

BROBECK SF

0020

(2) Public Knowledge or Use

Anticipation by prior knowledge requires that a complete and adequate description of the prior art reference must have been available to the public. See Rosemount, Inc. v. Beckman Instruments, Inc., 218 U.S.P.Q. 881 (C.D. Cal. 1983), aff'd 727 F.2d 1540 (Fed. Cir. 1984) ("the knowledge or use by others required by section 102(a) is public knowledge of a complete and operative device."). In addition, "the knowledge required by § 102(a) involves some type of public disclosure and is not satisfied by knowledge of a single person, or a few persons working together." Nat'l Tractor Pullers Ass'n v. Watkins, 205 U.S.P.Q. 892, 912 (N.D. Ill. 1980) (emphasis added).

Again, the inventor's testimony of prior knowledge or use must be corroborated by other evidence. See 1 Chisum, Chisum on Patents, §3.05[2] at 3-73.

In its opposition, Defendant argues that Madison provided her drawings "to Sunreeve via Kimura." See Def.'s Opp'n. at 14. However, Madison's testimony nowhere suggests that she disclosed her drawings to any Sunreeve employees other than Kimura. The

be done; is that correct?

A: Not right away. He said that they were talking about it, that they were discussing it with technical people.

Q: Right. But the ultimate conclusion was that it was not feasible?

A: At that time, yes.

Q: So it was at that point in time the manufacturer said it could not be reduced practice; would that be correct?

A: At that moment they had failed to come up with what I considered to be a workable alternative, or a workable or viable expression of the invention.

Q: And that was in 1994?

A: Yes."

See Madison, Vol. 2 at 177-178.



06/11/01 14:51

213 239 1300

BROBECK

0039

06/05/2001 17:46 FAX 415 442 1010

BROBECK SF

0021

1 inadmissible declaration of Nishioka, Deputy General Manager of  
2 Sunreeve, itself suggests that he was only verbally informed of  
3 Madison's ideas by Kimura, and does not indicate that Nishioka  
4 ever viewed the drawings in question. See Nishioka Decl. at ¶2  
5 (Kimura "reported to me that Ms. Julie Madison disclosed to him  
6 her ideas regarding the new construction of end-piece parts for  
7 magnetic eyewear, when he met with her prior to December 9, 1994  
8 at the Anaheim Hilton Hotel in California, U.S.A."). Thus,  
9 Defendant's evidence shows, at best, that Madison's drawings were  
10 disclosed only to Kimura, which is insufficient as a matter of  
11 law to constitute public knowledge. See Nat'l Tractor Pullers  
12 Ass'n v. Watkins, 205 U.S.P.Q. at 912.

13 Having examined all of the evidence, the Court concludes  
14 that Defendant has failed to raise a genuine issue of material  
15 fact as to patent invalidity. Defendant has failed to submit the  
16 Madison drawings, forcing the Court to rely on uncorroborated  
17 inventor testimony that her invention constitutes a prior art  
18 reference. In addition, there is no evidence that the Madison  
19 drawings, even assuming that they qualify as a prior art  
20 reference, were disclosed to the public in a manner constituting  
21 a "printed publication," or that sufficient public knowledge or  
22 use of such drawings occurred. As such, the Court need not reach  
23 the third element of patent invalidity -- whether Madison's  
24 drawings disclose each and every limitation of the invention  
25 claimed in the the '207 Patent.

26 //

27 //

28 //

JUN 11 01 05:49p

Therry's Desk

(954) 432-3840

P. 1

06/11/01 14:51

213 239 1300

BROBECK

0040

06/05/2001 17:46 FAX 415 442 1010

BROBECK SF

0022

1 VI. CONCLUSION

2 For the foregoing reasons, the Court GRANTS Plaintiff's  
3 motion for partial summary judgment on Defendant's counterclaim  
4 and affirmative defense of patent invalidity.  
5

6 IT IS SO ORDERED.

7  
8 DATED: June 4, 2001

Louder G. Bird  
9 LOURDES G. BIRD  
10 United States District Judge  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28